AF 3625

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

	Docket No.
	SLC-10102/29

In Re Application Of: **Wright**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/766,934	01/22/2001	Y. Garg	25006	3625	1234

Invention: **MASS CUSTOMIZATION BILLING ENGINE**

COMMISSIONER FOR PATENTS:

Transmitted herewith ~~in triplicate is~~ the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

February 4, 2005

☒   Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **$250.00**

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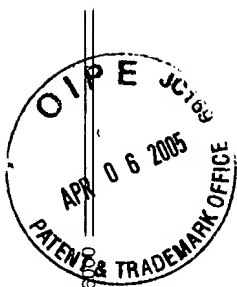
Dated: **April 4, 2005**

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P30SMALL/REV07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Wright

Serial No.: 09/766,934   Group No.: 3625

Filed: Jan. 22, 2001   Examiner: Y. Garg

For: MASS CUSTOMIZATION BILLING ENGINE

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I.   Real Party in Interest

The real party and interest in this case is Carl A. Wright, Applicant and Appellant.

II.   Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   Status of Claims

The present application was filed with 23 claims. Claims 5-7, 9, 11 and 13 were canceled by amendment in August 2004. Claims 8, 10, and 21-23 have been withdrawn from consideration. Claims 1-4, 12 and 14-20 are pending, rejected and under appeal. Claims 1 and 18 are independent.

IV.   Status of Amendments Filed Subsequent Final Rejection

A currently unentered after-final amendment is attached hereto correcting the dependency of claims 14 and 15.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method for providing particularized billing services. The method includes the step of selecting a client for whom a bill is to be produced, and performing various operations within a local, expanded, or global computing environment. These steps include extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client. At least one of the software objects is invoked to collect data pertinent to the client and to the specific fields in the bill format. This allows a bill to be generated having the defined bill format, with the data collected for the selected client in the appropriate fields. (Specification, page 3, line 16 to page 5, line 9).

Independent claim 18 resides in an automated system for generating particularized bills. The system includes a billing control application and a billing server application receiving instructions from the billing control application pertinent to a bill having a predetermined format for a client. One or more client usage data sources from which data pertinent to the predetermined format and to the specific client are retrieved and used to generate a bill having content particularized for that client. (Specification, page 16, lines 11 to 20).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claim 12 under 35 U.S.C. §112, first paragraph.

B. The rejection of claims 1-4 and 16-20 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,493,685 to Ensel.

C. The rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,493,685 to Ensel in view of EP 590332A1 to Siemens.

D. The rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,493,685 to Ensel in view of U.S. Patent Publication No. 2001/0014878A1 to Mitra et al.

E. The rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,493,685 to Ensel in view of U.S. Patent Publication No. 2001/0009002A1 to Logan et al.

VII. Arguments

A. The Rejection of Claim 12 under 35 U.S.C. §112, First Paragraph

Claim 12 stands rejected under 35 U.S.C. §112, first paragraph, on the grounds that, according to the Examiner, "selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill," was not described in the specification in such a way as to enable one skilled in the art to practice the invention. Appellant respectfully disagrees.

B. The Rejection of Claims 1-4 and 16-17 under 35 U.S.C. §102(e)

Claims 1-4 and 16-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,493,685 to Ensel. Ensel is directed to an Information Interface Provider (IIP) acting as the interface between a biller and its customers for both the presentment of electronic bills to the customers and for the processing of payments from the biller's customers. The IIP creates and electronically publishes bills to the biller's customers in response to data provided by the biller and processes the payments in response to instructions provided by the customers. Bill publication is accomplished through channels including Internet web sites, Email and personal digital assistants. The IIP formats the billing data for storage in its own internal database, and then performs the task of reformatting the bill for the particular channel(s) of distribution selected by the customer. Several types of customer payments are processed by the IIP including Automated Clearing House (ACH) payments, credit or debit card payments, paper checks, smart card payments, and digital currency payments. Once the IIP has debited the consumer's account for the payment, it credits the account of the biller. The IIP consolidates all of the Accounts Receivable (A/R) information and presents the biller with a single file which can then be used by the biller to update its own internal A/R systems.

Appellant's claimed subject matter is distinguishingly different in that the method generates customer-specific bills. Claim 1 includes, among other limitations, the steps of extracting a list of software objects ... operative to generate a predefined bill format with specific fields for *the selected client*; ... collect[ing] data *pertinent to the client* and to the specific fields in the bill format; and producing [a bill] *with the data collected for the selected client* in the appropriate fields (Emphasis added). Ensel does nothing of the sort. Indeed, Ensel does not describe any mechanism for the creation of bill *content* whereas the instant application is focused on the creation of bill content. Ensel is primarily an invention for mediating the billing, payment, and customer care services for one or more billers to many customers.

Reference is made to column 6, lines 39+ of Ensel, wherein it is described how a bill format is defined by an external source "biller." The passage reads in pertinent part:

"The IIP 20 places no restrictions on the format of the billing data 55 as it is received from biller 5, other than the IIP 20 has knowledge of the format of the data being delivered. As described in more detail below, it is the responsibility of the IIP 20 to reformat the billing data 55 in the format required for its own internal databases and then to format the actual published bill, statement or other information as is appropriate for the channel of distribution particular to a specific customer 80 receiving the presented bill or other information."

Thus, the billing data from the biller are standard or, at least, not subject to customer-specific modification. Although "reformatting" is carried out, this is done on a global basis, and only to accommodate a particular type of database or distribution channel. Column 6, line 44-50 discusses reformatting and formatting for the proper channel. In this context, the word "format" refers to formatting content for different media. For example, the bill content may be "formatted" into HTML or XML for web presentation. Alternatively, it may be formatted in PDF for download and printing. Yet another format for email distribution is noted. "Reformatting processor 245 executes mapping routines which reformats the ariously formatted billing data from the billers 5 into the format required for inclusion in the files 205-235 on database server 202." (Column 13, lines 7-10).

Although bills according to Ensel may have a different "look and feel," they look and feel is the same to all customers. "The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented *to its customers* 80 [Emphasis on the plural]. Alternatively, each biller can custom format the entire look and feel of its bill." (*see* Col. 10, line 65 to col. 11, line 5.)

Appellant's claims, however, include limitations regarding the creation of bill content for specific customers (clients). More particularly, whereas the claims of Appellant focus on the creation and ordering of bill content, Ensel resides in "formatting" for a media of display (See column 6, lines 56-67 and column 7, lines 1-5). Such passages refer to the conditional insertion of a marketing insert, for example, through the use of a query to review the current bills, again, *of all the customers*. Although this loosely resembles Applicant's software objects used to query data sources to calculate bill totals or subtotals, the Ensel invention refers to the insert as an existing document that is "sorted into" the bill

content based on the results of a query. This clearly teaches away from the actual generation of a particularized bill content.

Overall, the Ensel invention is focused on the mediation between billers and billed parties. It also is focused on the insulation of the biller form the complexities of multiple channels of distribution and payment. The instant invention, in contrast, claims various mechanisms to provide flexibility and customization for the creation of bill content.

At column 8, lines 18-21, Ensel refers to the ability to take "raw billing data" and format it for customer presentation. It makes no reference to any procedure, process or mechanism to create the formatted data. At column 9, lines 12-17, Ensel repeats its assertion of the ability to format billing data without any description of mechanism. With respect to Applicant's claimed use of "objects," Ensel at column 10, lines 65 refers to E-bill files being stored as objects in an object oriented file. Ensel refers to receiving these objects from an external source – there is no disclosure as to the creation of the objects.

Apart from the arguments set forth above with respect to independent claim 1, the Examiner argues on page 3 of the final Office Action that "in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's invention is directed to creation of bill content) are not recited in the rejected claim(s)," citing In Re Van Geuns. However, on this point, the Examiner is simply incorrect. Claim 18 (and therefore claims 19 and 20) include, among other limitations, client usage data sources operative to "generate a bill having content particularized for that client." Thus, not only does Appellant set forth content particularized for a client, but this set of claims also includes a limitation of "one or more client usage data sources," an aspect about which the Ensel reference is silent. Again, given the well-settled requirements for anticipation, this set of claims should be deemed allowable as well.

C.   The Rejection of Claims 18-20 under 35 U.S.C. §102(e)

Claims 18-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,493,685 to Ensel.

D.   The Rejection of Claim 12 under 35 U.S.C. §103(a)

Claim 12 stands rejected under 35 U.S.C. §103(a) over Ensel in view of Siemens (EP 590332A1). The Examiner concedes that Ensel does not disclose the steps of selecting a language in

which to produce a bill, nor does it disclose converting all correlated data to the selected language prior to creating the bill. The Examiner argues, however, that it would have been obvious to modify Ensel "because it would help the system for allowing a conversion to be made from a source language to the native language of the customer and would provide reduction in processing in comparison with system in which country [sic] has to carry translation programs for all other countries, and reduces number of translation programs as explicitly suggested by Siemens."

Apart from the fact that there is no foundation for any of these conclusions drawn by the Examiner, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. <u>Uniroyal Inc. v. Rudkin-Wiley Corp.</u>, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. <u>In Re Dembeczak</u>, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is nothing in the prior art that suggests the modification of Ensel "because it would help the system for allowing the conversion to be made from a source language to the native language of the consumer." Nor is there any teaching or suggestion from the prior art that would lead one to modify Ensel "to provide reduction in processing in comparison to the system in which the country has to carry translation programs for all other countries (as best understood)." Nor, further, is there any basis in the prior art to modify Ensel for the purpose of "reducing number of communication translation programs as explicitly suggested in Siemens." None of these issues represent any goals which the prior art addresses, or problems which the prior art attempts, or needs, to solve. Accordingly, *prima facie* obviousness has not been established.

D.   The Rejection of Claim 14 under 35 U.S.C. §103(a)

Claim 14 stands rejected under 35 U.S.C. §103(a) over Ensel in view of Mitra et al. (US 2001/0014878 A1). The Examiner concedes that Ensel does not disclose producing a closing bill. But argues that it would have been obvious to modify Ensel "to incorporate the feature of producing a

closing bill because it would have enable the system to present final bills to the consumers when the close or cancel the accounts." Not only is there a lack of teaching or suggestion to combine the references proposed by the Examiner, but there is no disclosure whatsoever in Ensel with respect to the generation of a closing bill. This is important, since the Ensel patent is broadly formulated and comprehensive in its disclosure. As such, Ensel had every opportunity to teach or suggest the concept of a "closing bill," but chose not to do so. Accordingly, *prima facie* obviousness is not applicable.

E. The Rejection of Claim 15 under 35 U.S.C. §103(a)

Claim 15 stands rejected under 35 U.S.C. §103(a) over Ensel in view of Logan et al. (US 2001/0009002 A1). The Examiner concedes that Ensel does not disclose producing a corrected bill. But argues that it would have been obvious to modify Ensel "to incorporate the feature of producing a closing bill because it would have enable the system to present final bills to the consumers when the close or cancel the accounts." Not only is there a lack of teaching or suggestion to combine the references proposed by the Examiner, but there is no disclosure whatsoever in Ensel with respect to the generation of a corrected bill. This is important, since the Ensel patent is broadly formulated and comprehensive in its disclosure. As such, Ensel had every opportunity to teach or suggest the concept of a "corrected bill," but chose not to do so. Accordingly, *prima facie* obviousness has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

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Date: April 4, 2005

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APPENDIX A

CLAIMS ON APPEAL

1. A method for providing particularized billing services, the method comprising the steps of:

selecting a client for whom a bill is to be produced, and performing the following operations within a local, expanded, or global computing environment;

extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client;

invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format; and

producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields.

2. The method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format.

3. The method of claim 1, wherein the collected data further comprises detailed information pertinent to a billing account of the client.

4. The method of claim 3, further comprising the step of segmenting the detailed information into different portions of the bill.

12. The method of claim 1, further comprising the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill.

14. The method of claim 13, wherein the defined bill format further comprises a closing bill.

15. The method of claim 13, further comprising the step of producing a duplicate bill.

16. The method of claim 1, wherein the defined bill format further comprises a corrected bill image.

17. The method of claim 1, wherein producing the bill further comprises one or more of the following: presenting a bill image on a display device, printing a bill, sending a bill via email, and sending a bill via facsimile.

18. An automated system for generating particularized bills, the system comprising:

a billing control application;

a billing server application receiving instructions from the billing control application pertinent to a bill having a predetermined format for a client; and

one or more client usage data sources from which data pertinent to the predetermined format and to the specific client are retrieved and used to generate a bill having content particularized for that client.

19. The system of claim 18, further comprising an error correction module used in conjunction with the billing control application and the billing server application.

20. The system of claim 18, wherein the billing server application further comprises interactive and batch functionality.

APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.

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